

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Venegas, Jr.

Serial No.: 09/829,033

Group No.: 2875

Filed: April 9, 2001

Examiner: Sawhney

For: LIGHTED STANCHION COVER

APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party in interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are two previous appeals in the above-referenced matter that may have a bearing on the Board's decision in the pending appeal. The second appeal resulted in a BPAI Decision rendered May 22, 2009 (copy of which is submitted as Appendix B Evidence Item No. 3 herein).

III. Status of Claims

The present application was filed with 12 claims. Claim 13 was added by amendment in July 2009. Claims 2-11 and 13 have been canceled. Claim 12 has been allowed. Claims 1 and 12 are pending; however, claim 1 is rejected and under appeal. Claim 1 is sole rejected independent claim.

IV. Status of Amendments

No after-final amendments have been filed.

V. Summary of the Claimed Subject Matter

Independent claim 1 is directed to a lighting assembly for use with a stanchion (12) extending outwardly from a ground surface (16). The assembly includes an elongated tubular body (22) having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface. A lighting assembly includes a light source (14) interconnected to a power source (32, 32'), the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity. (Specification, page 5, line 12 to page 7, line 21). The assembly further includes a proximity detector and control electronics operative to activate the light source when a vehicle is in close proximity to the stanchion. (Specification, page 6, lines 17 to 20).

VI. Grounds of Rejection to be Reviewed on Appeal

A. The rejection of claim 1 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 4,344,110 to Ruediger in view of UK Patent No. GB2344915 to Baker.

VII. Argument

A. The Rejection of Claim 1.

Claim 1 stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 4,344,110 to Ruediger in view of UK Patent No. GB2344915 to Baker.

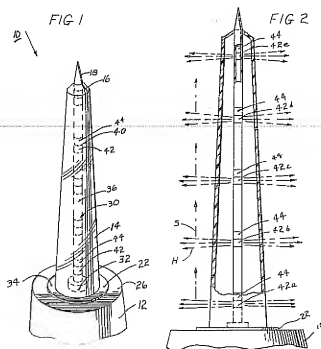
According to the Examiner, Ruediger discloses a lighting assembly 10 (see below) “capable of being used with a stanchion.” The Examiner gives no explanation as to how this is possible with Ruediger, especially since it appears to Appellant that at least the base 32 would interfere with this application.

Baker resides in a small portable voice messaging and warning device that includes an infrared movement detector primarily to assist blind or partially sighted people.

The Examiner concedes that Ruediger fails to teach a proximity detector and control electronics operative to activate the light source when a vehicle is in close proximity to the stanchion, but contends

that it would be obvious to modify Ruediger with Baker "for the benefits of secured environment for the device, its operation and the users." (Final OA, page 3)

Appellant does not understand what is meant by a "secured environment." Regardless of the definition, Ruediger has no need whatsoever for a proximity detector. Ruediger is directed to a channel marker to be used in the water. Ruediger teaches away from mounting relative to a ground surface to warn "a vehicle." Ruediger seems incapable of being used with a stanchion. Where the teachings of two or more prior art references conflict, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, the Examiner's proposed combination of Ruediger and Baker makes no sense.

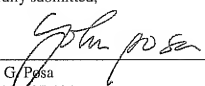


Conclusion

This application was originally filed in April 2001. This is the third appeal; the Examiner withdrew the first on largely similar points of argument. For all of the arguments of record, all pending claims of the subject application continue to be in condition for allowance, and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____


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APPENDIX A
CLAIMS ON APPEAL

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface;

a source of electrical power disposed inside or outside of the elongated tubular body; and

a lighting assembly having a light source interconnected to the power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity; and

further including a proximity detector and control electronics operative to activate the light source when a vehicle is in close proximity to the stanchion.

APPENDIX B

EVIDENCE

- 1) *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)
- 2) *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)
- 3) Decision on Appeal, Appeal No. 2008-5559, May 22, 2009



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Source: USPO, 2d Series (1986 - Present) > U.S. Court of Appeals, Federal Circuit > In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991)

18 USPQ2d 1089

In re Young

U.S. Court of Appeals Federal Circuit

No. 90-1368

Decided March 5, 1991

927 F2d 588

Headnotes

PATENTS

[1] Patentability/Validity - Obviousness - Relevant prior art - In general (► 115.0903.01)

Apparently conflicting prior art references must, in making obviousness determination, each be weighed for their power to suggest solutions to artisan of ordinary skill, and all disclosures in prior art must be considered to extent that they are in analogous fields of endeavor and thus would have been considered by person of ordinary skill in field of invention; in weighing suggestive power of each reference, degree to which one reference might accurately discredit another must be considered.

[2] Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (► 115.0903.03)

Applicant's claims for method of generating seismic pulse in water by use of at least three air guns disposed at critical distance from each other are obvious in view of prior patent which expressly teaches exact spacing set forth as limitation in each of applicant's claims, even though additional reference purporting to test different methods of pulse generation suggests avoidance of spacing taught in prior patent, since reference did not accurately test prior patent according to its teachings, particularly those regarding spacing, and therefore artisan of ordinary skill would have afforded reference little weight.

Case History and Disposition

Page 1090

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of D. Raymond Young and John C. Wride (method and apparatus for generating an acoustic pulse in a body of water). From decision of Board of Patent Appeals and Interferences upholding final rejection of all claims, applicants appeal. Affirmed.

Attorneys

Richard F. Phillips, Jr., Houston, Texas, for appellants.

Lee E. Barrett, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), Arlington, Va., for appellee Patent and Trademark Office.

Judge

Before Newman, Lourie, and Rader, circuit judges.

Opinion Text

Opinion By:

Rader, J.

Raymond Young and his co-inventor John Wride (collectively Young) appeal from the October 31, 1989 and April 18, 1990 decisions of the Board of Patent Appeals and Interferences (Board). These decisions *affirmed* the final rejection of all claims in their application. The Board held Young's claimed invention obvious under 35 U.S.C. §103. This court affirms.

BACKGROUND

Young's application discloses a method and apparatus for generating an acoustic pulse in water. Acoustic pulse technology facilitates offshore seismic exploration. The acoustic pulse generates a large gas bubble in the ocean above geological formations on the ocean floor. The rapid expansion and collapse of the gas bubble create a shock wave in the water. The shock wave propagates through the water into the formations below the ocean bed. As the shock wave passes downward through these formations, each interface between adjoining earth strata reflects a portion of the shock wave. These reflections move upward through the ocean. Hydrophones at the ocean's surface can monitor these reflections. From these monitored reflections, geologists can generate a "seismic section" map which shows the configuration of strata in the ocean bed.

Today's most common sources of seismic shock waves are air guns. These air guns feature a chamber for storing and releasing on command highly compressed air. A high-pressure hose charges the gun with compressed air for rapid firing during a seismic survey.

Acoustic pulse technology suffers from problems with bubble oscillation. Upon release of the compressed air, the bubble undergoes a rapid initial expansion and collapse. Several more expansions and collapses follow the initial collapse, but with diminishing amplitude. Each of these expansion-collapse events creates an additional shock wave. The geological strata reflect each of these additional shock waves. The multiple reflections, in turn, blur the resolution of the seismic section. Most blurring comes from the first oscillation after the initial bubble collapse.

Acoustic pulse technology uses a "primary-to-bubble ratio" to measure susceptibility to oscillation. This ratio compares the shock wave intensity of the initial expansion-collapse to the intensity of the first oscillation. A high ratio means the secondary shock waves are less likely to blur the seismic section.

Young tries to raise the primary-to-bubble ratio above prior art air gun sources by reducing the amplitude of the first oscillation. Young seeks this result by spacing at least three air guns in a characteristic array. The array separates the guns from each other by a critical distance. The distance, D , is at least 1.2 times greater than R , but less than or equal to twice R . R is the maximum radius of the initial air bubble from each gun. * With this spacing, the bubbles from each gun intersect before any single bubble reaches its maximum radius. This intersection dampens the overall oscillation. Young's independent claims each include a spacing limitation within this range.

* Mathematically, D is defined by $1.2 R \leq D \leq 2.0 R$.

Independent claim 1 is illustrative: A method of producing a seismic pulse in a body of water, including the steps of:

- (a) disposing in the water a set of at least three air guns, each adapted to produce in the water a gas bubble having maximum radius substantially equal to the quantity R , where the guns are disposed at depths such that each produces, when fired, a bubble of maximum radius R , and the guns are disposed such that each gun is separated from each of the nearest guns thereto in the set by a critical distance, D , where D is substantially equal to $\sqrt{2}R$; and
- (b) firing the air guns substantially simultaneously to produce a seismic pulse in the water.

Young's dependent claims define the number of the guns or their placement relative to each other or to the ocean surface.

The examiner rejected each of the claims as obvious under 35 U.S.C. §103 in light of five prior art references. The examiner relied primarily on U.S. Patent No. 2,619,186 to Carlisle (the "Carlisle patent" or "Carlisle") to reject Young's claims. Carlisle is the only reference cited by the examiner or Board which suggests the air gun spacing in Young's claims.

Young contested the Board's and the examiner's consideration of Carlisle. Young *argued* that Carlisle concerns reducing bubble oscillation for chemical explosives, not air guns. Young also *argued* that an article by Knudsen published six years after Carlisle in the journal *Geophysics* expressly discredits the teachings of Carlisle. W. Knudsen, *Elimination of Secondary Pressure Pulses in Offshore Exploration (A Model Study)*, 23 *Geophysics* No. 3 at 440 (July 1958) (Knudsen). Therefore, Young contended, a person of ordinary skill in the seismic exploration art would not have considered Carlisle when developing an improved seismic array.

The Board rejected Young's arguments. The Board held that the examiner appropriately applied Carlisle

notwithstanding the teachings of Knudsen. On appeal, Young asserts as error only the propriety of applying Carlisle as a reference in light of Knudsen's allegedly contrary teachings.

DISCUSSION

This court must decide whether the Board properly *affirmed* the examiner's rejection over Carlisle. Young has not challenged the other references cited in the examiner's rejection. Further, Young has not *argued* the merits of any particular claim apart from the others. Therefore, all claims stand or fall together with representative independent claim 1. See *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed.Cir. 1983).

The Carlisle patent - "Seismic Exploration Method" - issued on November 25, 1952. Carlisle concerns minimizing bubble oscillation for chemical explosives used in marine seismic exploration. Carlisle controls bubble oscillation by spacing seismic sources to achieve a reduction of the secondary pressure pulse. Carlisle specifically teaches spacing the seismic sources close enough to allow the bubbles to intersect before reaching their maximum radius. Carlisle spaces the bubble centers closer than two maximum bubble radii, or less than "2.0 R" in Young's notation. Carlisle, col. 3, lines 57-60. Carlisle explains:

he secondary energy normally available from these sources is dissipated by their mutual intersection and tends to eliminate the secondary seismic impulses created when the walls of the bubbles collapse.

Id. at lines 60-64. Thus, Carlisle expressly teaches the spacing limitation in each of Young's claims.

Notwithstanding Carlisle's teachings, Young argues that the Knudsen article discredits Carlisle. Knudsen describes a series of tests which evaluated four proposed techniques for suppressing bubble oscillation. Carlisle was one of the four. Knudsen's article opined that Carlisle yields no appreciable improvement in bubble oscillation suppression. The effective teaching of the Knudsen/Carlisle combination, Young argues, suggests avoidance of the spacing suggested in Carlisle. Therefore, Young would have this court conclude that his use of Carlisle's spacing would not have been obvious.

Young misunderstands the effect that Knudsen has on Carlisle. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Even if tending to discredit Carlisle, Knudsen cannot remove Carlisle from the prior art. Patents are part of the literature of the art and are relevant for all they contain. *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). For example, in *In re Eitter*, 756 F.2d 852, 859, 225 USPQ 1, 6 (Fed.Cir.), cert. denied, 474 U.S. 828 (1985), a reference which disclosed obsolete technology remained in the prior art. This court considered the reference for what it disclosed in relation to the claimed invention.

[1] When prior art contains apparently conflicting references, the Board must weigh each reference for its power to suggest solutions to an artisan of ordinary skill. The Board must consider all disclosures of the prior art, *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976), to the extent that the references are, as here, in analogous fields of endeavor and thus would have been considered by a person of ordinary skill in the field of the invention. The Board, in weighing the suggestive power of each reference, must consider the degree to which one reference might accurately discredit another.

[2] As prior art, the Board correctly weighed Carlisle to determine the patentability of Young's claims. Carlisle expressly teaches both the method and the advantages

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of Young's claimed spacing. In fact, Carlisle expressly teaches the exact spacing set out as a limitation in Young's claims. Thus, the Board correctly attributed significant weight to Carlisle in its obviousness determination.

In determining what weight to accord to Carlisle as prior art, the Board also appropriately considered Knudsen's discrediting effect. The Board determined that Knudsen did not convincingly discredit Carlisle. Therefore, the Board appropriately concluded that Knudsen would not have led one skilled in the art to reject Carlisle.

Knudsen did not test Carlisle according to its teachings. For instance, Knudsen did not use an explosive charge in modeling Carlisle. Rather, Knudsen tried to simulate Carlisle with a capacitive electrical discharge in a barrel of oil.

Knudsen did not replicate Carlisle's teachings on spacing. Knudsen tried to model Carlisle by separating the seismic sources by one, two and three bubble radii. Knudsen at 42. At the maximum spacing of three bubble radii, the bubbles will not intersect at all. Carlisle specifically requires spacing to permit bubble intersection. Carlisle, col. 4, lines 47-52. At a spacing of one bubble radius, the two bubbles coalesced into one before the initial collapse. Knudsen at 45. If just one bubble is present, the bubble will oscillate as if no second seismic source was present. Carlisle specifically requires spacing to prevent the formation of one bubble. Carlisle, col.

4, lines 34-37. Finally, at the two bubble radii spacing in Knudsen, the bubbles will just barely intersect. Carlisle requires that the bubbles intersect before each bubble achieves its maximum radius. Carlisle, col. 3, lines 58-60. In sum, Knudsen did not duplicate or appropriately model Carlisle's spacing.

Knudsen's conclusion that Carlisle would "not be effective in eliminating the secondary pressure pulse" also directly contradicts data contained in Knudsen. The Knudsen data point for the two-radii horizontal bubble spacing, although not a completely accurate model of Carlisle, shows a 30% reduction of the secondary pressure pulse. Knudsen at 45, Table 4. This data point represents the only point where Knudsen approximates the spacing shown in Carlisle. At that point, Knudsen confirmed Carlisle's teachings.

The Board found that Knudsen "did not test the Carlisle technique under conditions which are directly comparable to the Carlisle disclosure." Weighing the discrepancies between the Knudsen model and Carlisle's teachings, as well as Knudsen's tendency to confirm Carlisle where the model approximated Carlisle, the Board concluded: "we do not agree that Knudsen discredits Carlisle."

Because Knudsen did not accurately test Carlisle, an artisan of ordinary skill would not have dismissed Carlisle in light of Knudsen as a whole. It is far more likely that the skilled artisan would have afforded little weight to Knudsen itself. The Board did not err in relying on Carlisle and discounting Knudsen.

CONCLUSION

Knudsen is not so credible or persuasive of a contrary teaching that it would have deterred the skilled artisan from using the teachings of Carlisle. The examiner's use of Carlisle in his rejection of Young's claims is not clearly erroneous. The Board's decision affirming the examiner's rejection is therefore **AFFIRMED**.

- End of Case -

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16 USPQ2d 1430

In re Mills

U.S. Court of Appeals Federal Circuit

No. 90-1184

Decided October 9, 1990

916 F2d 680

Headnotes

PATENTS

[1] Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (► 115.0903.03)

Apparatus which produces aerated cementitious composition by driving output pump for its mixing chamber at capacity greater than feed rate of ingredients into mixing chamber, and thereby drawing air into composition, is not obvious in view of prior patent for mixing apparatus, even though device of prior patent provides for regulation of flow rate into mixing chamber, since patent contains no suggestion or motivation for overdriving output pump so as to entrain air in mixed ingredients.

[2] Patentability/Validity - Anticipation - In general (► 115.0701)

Patentability/Validity - Obviousness - Relevant prior art - In general (► 115.0903.01)

Board of Patent Appeals and Interferences erred by requiring applicant to show that prior art reference lacked functional characteristics of claimed device, since even though such requirement would be proper for rejection based on lack of novelty, it is not pertinent whether prior art device possesses claimed invention's functional characteristics if, as here, application was rejected on basis of obviousness and reference does not describe or suggest claimed invention's structure.

Case History and Disposition

Page 1431

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Peter S. Mills, serial no. 891,374, continuation of serial no. 607-805, filed May 4, 1984. From decision upholding examiner's rejection of claims 6-9 and 11-14, applicant appeals. Reversed.

Attorneys

James C. Wray, McLean, Va, for appellant.

Muriel E. Crawford, assistant solicitor (Fred E. McKelvey, solicitor, with her on brief), for appellee.

Judge

Before Miller, senior circuit judge, and Mayer and Lourie, circuit judges.

Opinion Text

Opinion By:

Lourie, J.

This appeal is from the November 2, 1989, decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (Board), Appeal No. 88-0141, affirming the examiner's rejection, under 35 U.S.C. §103, of claims 6-9 and 11-14 in Mills' application Serial No. 891,374, a continuation of Serial No. 607-805, filed May 4, 1984, entitled "Methods of and Apparatus for Producing Aerated Cementitious Compounds." The remainder of the claims (1-5, 10, and 15) have all been cancelled. We reverse.

I

BACKGROUND

A. The Invention

Mills' claimed invention is an apparatus for producing aerated cementitious compositions. Claim 6 is the broadest claim:

6. Apparatus for producing an aerated cementitious composition, comprising
a mixing chamber being open to atmosphere and containing mixing means,
feed means for feeding ingredients comprising cement, foaming agent and liquid to the mixing chamber,
mixing means for mixing ingredients fed to the mixing chamber, pump means for pumping the mixed ingredients to a desired site and having a pump inlet connected to an outlet of the mixing chamber,
drive motor means connected through gearbox means providing a pumping capacity of the pump means greater than the feed rate of the ingredients to the mixing chamber provided by the feed means, such that in operation air is drawn into the mixing chamber, and entrained in the mixed ingredients.

The essence of Mills' invention is the machine's ability to aerate a cementitious composition by driving the output pump at a capacity greater than the feed rate, thereby drawing air into the composition. This aeration produces a composition with substantially lower density than standard cementitious composition mixing ingredients.

B. The Reference

The sole reference upon which the Board relied in affirming the examiner's rejection was Mathis et al. U.S. Patent 4,117,547 (Mathis).¹ Mathis discloses a mixing chamber which is open to the atmosphere and which contains a mixing means. Two feed means for feeding ingredients in the mixing chamber are provided. The first feed means may consist of a screw conveyor and the second, a flow metering device such as an adjustable valve. A pump means pumps the mixture from the mixing chamber to a desired site and a drive motor means is connected to mixing means and pump means. A separate motor drives the feed means.

¹ The examiner rejected the claims at issue under 35 U.S.C. §103 as being unpatentable not only over Mathis but also in view of Gibson et al. U.S. Patent 2,717,770. However, the Board affirmed the examiner's rejection of claims 6-9 and 11-14 based solely on the Mathis reference. With regard to Gibson the Board stated:

We view the teachings of Gibson at best as being merely confirmatory of the fact that aerated mixtures can be produced by machines in which a pump means operates upon a mixing chamber at a greater rate than the ingredients are fed thereunto so that air is drawn into the mixing chamber and entrained in the mixed ingredients.

App. 2.

A control system exists to arrest the feed means so as not to overfill the mixing chamber. This system comprises a level detector in the mixing chamber, which signals the feed means to close when the mixing chamber stores the predetermined maximum permissible quantity of material.

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C. The Rejection

The Board affirmed the examiner's Section 103 rejection of claims 6-9 and 11-14, "finding correspondence in the Mathis reference for all of the subject matter recited in the appellants' claims. ..." With regard to Mills' claim language relating to aerating the mixture, the Board stated: "[I]n our opinion, the differences between claim 6 and the Mathis machine ... lie solely in the functional language of the claim." The Board further found that Mathis teaches the use of separate input and output motors in order to permit the various mixing means and pumps to operate at different rates, and that Mathis "contemplates a situation wherein the rate of the outlet pump would be greater than the inlet pumps. ..." The Board concluded on this point: "[w]e are of the opinion that the Mathis machine is capable of being operated in such a fashion as to cause [the output] pump

18 to draw air into the mixing chamber 17 so that it is entrained in the mixture.”

The Board also agreed with Mills’ contention that Mathis is not directed to the problem of producing aerated cementitious material, but noted that Mills is not claiming a method, but an apparatus, and all of Mills’ apparatus structure is present in the Mathis machine.

II

DISCUSSION

All of the rejected claims are apparatus claims. The Board found “correspondence in the Mathis reference for all of the subject matter recited in appellants’ claims” and that “[t]he Mathis machine discloses all of the structure set forth in claim 1” (a method claim not before us). It asserts that the use of such a mechanism would have been obvious and that the differences between claim 6 and the Mathis machine lie solely in the functional language of the claim, the preamble merely stating an intended use for the machine. This language suggests a lack of novelty rejection under 35 U.S.C. §102, rather than an obviousness rejection. However, no Section 102 rejection has been made or is before us. What is before us is a rejection for obviousness, and we must decide whether the Board erred in that rejection.

We note first that nonobviousness is a question of law to be determined from the facts. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed.Cir. 1983). We review the Board’s determination of obviousness, based on the scope and content of the Mathis reference and the differences between the Mathis reference and the Mills claims, for correctness or error. *In re Carleton*, 599 F.2d 1021 1024 n.14, 202 USPQ 165 , 169 n.14 (CCPA 1979).

[1] After reviewing the record, the arguments in the briefs, and the Mathis reference, we conclude that Mathis would not have rendered the claimed invention obvious. The closest Mathis comes to suggesting Mills’ claimed apparatus is at column 3, lines 42-47, which states

he rate at which the Inlet 2b receives a solid constituent depends on the speed of the feed screw 4. Such speed can be regulated by a prime mover 6 which includes a variable-speed transmission.

This brief reference contains no suggestion of “pump means and the feed means providing a pumping capacity of the pump means greater than the feed rate of ingredients to the mixing chamber provided by the feed means, such that in operation air is drawn into the mixing chamber, and air entrained in the mixed ingredients,” as provided for in Mills’ claim 6. While Mathis’ apparatus may be capable of being *modified* to run the way Mills’ apparatus is claimed, there must be a suggestion or motivation in the reference to do so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir. 1984) (“The mere fact that the prior art could be so *modified* would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). We see no such suggestion. The apparatus claimed by Mills is different from that of Mathis, since the fact that motor 6 of Mathis (the feed means) can be run at a variable speed does not require that motor 20 (connected to the pump) be run at a lesser speed “such that in operation air is drawn into the mixing chamber and air entrained in the mixed ingredients.”

[2] The Board found that the difference between the claimed subject matter and the prior art resided solely in functional language and that appellant had to show that the prior art device lacked the functional characteristics of the claimed device, citing *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). *Ludtke*, however, dealt with a rejection for lack of novelty, in which case it was proper to require that a prior art reference cited as anticipating a claimed invention be shown to lack the characteristics of the claimed invention. That proof would in fact negate the assertion that the claimed invention was described in the prior art. We are here, however, facing an obvious

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ness issue. It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure. That is the case here. Given the facts before us, we hold that the Board was in error in affirming the examiner’s rejection of claims 6-9 and 11-13 as obvious in view of Mathis, and we therefore reverse the Board.

REVERSED

- End of Case -

Source: USPQ, 2d Series (1986 - Present) > U.S. Court of Appeals, Federal Circuit > *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)

16 USPQ2d 1430

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Attorneys

James C. Wray, McLean, Va, for appellant.

Muriel E. Crawford, assistant solicitor (Fred E. McKelvey, solicitor, with her on brief), for appellee.

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Before Miller, senior circuit judge, and Mayer and Lourie, circuit judges.

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I

BACKGROUND

A. The Invention

Mills' claimed invention is an apparatus for producing aerated cementitious compositions. Claim 6 is the broadest claim:

6. Apparatus for producing an aerated cementitious composition, comprising
a mixing chamber being open to atmosphere and containing mixing means,

feed means for feeding ingredients comprising cement, foaming agent and liquid to the mixing chamber,
mixing means for mixing ingredients fed to the mixing chamber, pump means for pumping the mixed ingredients to a desired site and having a pump inlet connected to an outlet of the mixing chamber,
drive motor means connected through gearbox means providing a pumping capacity of the pump means greater than the feed rate of the ingredients to the mixing chamber provided by the feed means, such that in operation air is drawn into the mixing chamber, and entrained in the mixed ingredients.

The essence of Mills' invention is the machine's ability to aerate a cementitious composition by driving the output pump at a capacity greater than the feed rate, thereby drawing air into the composition. This aeration produces a composition with substantially lower density than standard cementitious composition mixing ingredients.

B. The Reference

The sole reference upon which the Board relied in affirming the examiner's rejection was Mathis et al. U.S. Patent 4,117,547 (Mathis).¹ Mathis discloses a mixing chamber which is open to the atmosphere and which contains a mixing means. Two feed means for feeding ingredients in the mixing chamber are provided. The first feed means may consist of a screw conveyor and the second, a flow metering device such as an adjustable valve. A pump means pumps the mixture from the mixing chamber to a desired site and a drive motor means is connected to mixing means and pump means. A separate motor drives the feed means.

¹ The examiner rejected the claims at issue under 35 U.S.C. §103 as being unpatentable not only over Mathis but also in view of Gibson et al. U.S. Patent 2,717,770. However, the Board *affirmed* the examiner's rejection of claims 6-9 and 11-14 based solely on the Mathis reference. With regard to Gibson the Board stated:

We view the teachings of Gibson at best as being merely confirmatory of the fact that aerated mixtures can be produced by machines in which a pump means operates upon a mixing chamber at a greater rate than the ingredients are fed thereunto so that air is drawn into the mixing chamber and entrained in the mixed ingredients.

App. 2.

A control system exists to arrest the feed means so as not to overfill the mixing chamber. This system comprises a level detector in the mixing chamber, which signals the feed means to close when the mixing chamber stores the predetermined maximum permissible quantity of material.

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C. The Rejection

The Board *affirmed* the examiner's Section 103 rejection of claims 6-9 and 11-14, "finding correspondence in the Mathis reference for all of the subject matter recited in the appellants' claims. ..." With regard to Mills' claim language relating to aerating the mixture, the Board stated: "[i]n our opinion, the differences between claim 6 and the Mathis machine ... lie solely in the functional language of the claim." The Board further found that Mathis teaches the use of separate input and output motors in order to permit the various mixing means and pumps to operate at different rates, and that Mathis "contemplates a situation wherein the rate of the outlet pump would be greater than the inlet pumps...." The Board concluded on this point: "[w]e are of the opinion that the Mathis machine is capable of being operated in such a fashion as to cause [the output] pump 18 to draw air into the mixing chamber 17 so that it is entrained in the mixture."

The Board also agreed with Mills' contention that Mathis is not directed to the problem of producing aerated cementitious material, but noted that Mills is not claiming a method, but an apparatus, and all of Mills' apparatus structure is present in the Mathis machine.

II

DISCUSSION

All of the rejected claims are apparatus claims. The Board found "correspondence in the Mathis reference for all of the subject matter recited in appellants' claims" and that "[t]he Mathis machine discloses all of the structure set forth in claim 1" (a method claim not before us). It asserts that the use of such a mechanism would have been obvious and that the differences between claim 6 and the Mathis machine lie solely in the functional language of the claim, the preamble merely stating an intended use for the machine. This language suggests a lack of novelty rejection under 35 U.S.C. §102, rather than an obviousness rejection. However, no Section 102 rejection has been made or is before us. What is before us is a rejection for obviousness, and we

must decide whether the Board erred in that rejection.

We note first that nonobviousness is a question of law to be determined from the facts. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed.Cir. 1983). We review the Board's determination of obviousness, based on the scope and content of the Mathis reference and the differences between the Mathis reference and the Mills claims, for correctness or error. *In re Carleton*, 599 F.2d 1021 1024 n.14, 202 USPQ 165 , 169 n.14 (CCPA 1979).

[1] After reviewing the record, the arguments in the briefs, and the Mathis reference, we conclude that Mathis would not have rendered the claimed invention obvious. The closest Mathis comes to suggesting Mills' claimed apparatus is at column 3, lines 42-47, which states

he rate at which the inlet 2b receives a solid constituent depends on the speed of the feed screw 4. Such speed can be regulated by a prime mover 6 which includes a variable-speed transmission.

This brief reference contains no suggestion of "pump means and the feed means providing a pumping capacity of the pump means greater than the feed rate of ingredients to the mixing chamber provided by the feed means, such that in operation air is drawn into the mixing chamber, and air entrained in the mixed ingredients," as provided for in Mills' claim 6. While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). We see no such suggestion. The apparatus claimed by Mills is different from that of Mathis, since the fact that motor 6 of Mathis (the feed means) can be run at a variable speed does not require that motor 20 (connected to the pump) be run at a lesser speed "such that in operation air is drawn into the mixing chamber and air entrained in the mixed ingredients."

[2] The Board found that the difference between the claimed subject matter and the prior art resided solely in functional language and that appellant had to show that the prior art device lacked the functional characteristics of the claimed device, citing *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). *Ludtke*, however, dealt with a rejection for lack of novelty, in which case it was proper to require that a prior art reference cited as anticipating a claimed invention be shown to lack the characteristics of the claimed invention. That proof would in fact negate the assertion that the claimed invention was described in the prior art. We are here, however, facing an obvious

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ness issue. It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure. That is the case here. Given the facts before us, we hold that the Board was in error in affirming the examiner's rejection of claims 6-9 and 11-13 as obvious in view of Mathis, and we therefore reverse the Board.

REVERSED

- End of Case -

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK VENEGAS, JR.

Appeal 2008-5559
Application 09/829,033
Technology Center 2800

Decided:¹ May 22, 2009

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 the final rejection of claims 1-11. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

We AFFIRM.

Appellant claims a lighting assembly for use with a stanchion extending outwardly from a ground surface (claim 1).

Claim 1 is illustrative:

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

The Examiner relies on the following prior art references as evidence of unpatentability:

Morse, Jr.	3,855,924	Dec. 24, 1974
Padilla	4,819,135	Apr. 4, 1989
Moore	5,121,307	Jun. 9, 1992

The appealed rejections are as follows:

1. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore.
2. Claims 7 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Morse, Jr.
3. Claims 9-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Padilla.

With regard to rejection (1), Appellant argues claims 1-6 as a group of which we select claim 1 as representative in rendering our decision.

With regard to rejection (2), Appellant argues claims 7 and 8 as a group of which we select claim 7 as representative in rendering our decision.

With regard to rejection (3), Appellant argues claims 9-11 as a group of which we select claim 9 as representative in rendering our decision.

Rejection (1): § 103 over Moore

STATEMENT OF THE CASE

Appellant argues that Moore does not teach or suggest “an open end [of the elongated tubular body of the lighting assembly] is proximate to or in contact with the ground surface” as required by claim 1 (App. Br. 2-3). Appellant contends that Moore’s cover could not extend down to a ground surface due to the wires and other obstacles the telephone and utility poles are designed to produce, and extending the cover down would defeat a purpose for which the prior art is intended (App. Br. 3).

The Examiner contends that changing the length of Moore’s cylindrical housing 11 to extend the length of the pole would have been a mere change in the size of the housing and would have provided better protection to the pole as supported by the admitted prior art in the “Background of Invention” section of the Specification (Ans. 4-5).

ISSUE

Has Appellant shown that the Examiner reversibly erred in determining that it would have been obvious to change the length of Moore’s cylindrical housing such that “the open end is proximate to or in

contact with the ground surface” as required by claim 1? We decide this issue in the negative.

PRINCIPLES OF LAW

For a *prima facie* case of obviousness all the claim features must be taught or suggested by the applied prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

The applicant bears the procedural burden of showing error in the Examiner’s rejections. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness”) (citation and internal quote omitted).

FACTUAL FINDINGS (FF)

1. The Examiner finds that Moore discloses a covering for a pole.

Moore’s covering has an elongated tubular body for positioning over a pole with a light on the tubular body (Ans. 4). Appellant does not dispute this finding (App. Br. 2-3).

2. Appellant does not contest the Examiner’s determination that:

It would have been obvious . . . to modify the lighted assembly of Moore . . . by extending the length of the elongated tubular body, and accommodating entire stanchion within itself, or making its open end proximate the ground, since such a modification would have involved a mere change in size of the component. In addition, encasing the stanchion substantially entirely would shield its surface from damage resulting from external moving elements, and improvement in aesthetic appearance . . . The above-indicated motivation is also supported by the prior art admitted by the applicant, and included in the section entitled “Background of Invention” of the disclosure. (Ans. 4-5; App. Br. 2-3).

3. Moore discloses a solar powered strobe light serving as a warning device for low flying aircraft (col. 1, ll. 7-9). The strobe light may operate on or near tall structures and other locations where typical means of powering warning devices is hindered or prohibited (col. 1, ll. 15-20).
4. Moore discloses that the strobe light may be mounted on a tower, pole or other structure and used as an emergency marker or permanent safety fixture particularly for helicopters or other low flying aircraft (col. 2, ll. 12-17; 40-45). Moore does not limit the size of the pole or structure on which the strobe light is mounted.

ANALYSIS

Appellant contends that the claim feature requiring that the bottom end of the cover is proximate to, or in contact with, a ground surface distinguishes over Moore. The Examiner admits that Moore does not specifically teach that the open end of the lighting assembly is proximate to the ground (Ans. 4). However, Appellant has not shown error in the Examiner's determination that it would have been obvious to lengthen Moore's tubular body to cover a pole such that the end of the covering is proximate to or in contact with the ground surface because such is a mere change in size which would better protect the stanchion (Ans. 4-5).

Rather, Appellant contends that lengthening Moore's tubular body would defeat a purpose of the telephone pole, on which the Moore's light assembly is mounted, by interfering with the wires or beams thereon (App. Br. 3). However, Moore does not appear to limit the size of the pole or structure on which the strobe light may be mounted. Instead, Moore seems to indicate that the critical feature is that the strobe light provides an

emergency marker or permanent safety fixture for low flying aircraft. In other words, the strobe light may be attached to smaller poles or structures as long as it provides relevant information to helicopters and low flying aircraft. Accordingly, Appellant's argument is not persuasive.

We further note that whether the claimed lighting assembly has an open end proximate to or in contact with the ground surface depends upon the size of the stanchion, which is not claimed. In other words, it would have been obvious to place Moore's light assembly on a stanchion sized such that the light assembly's tubular body has its open end proximate to or in contact with a ground surface. As noted above, Moore does not limit the size of the pole on which the lighting assembly can be mounted.

For the above reasons, we determine that Appellant has not shown that the Examiner erred in determining that it would have been obvious to modify Moore's lighting assembly such that the open end of the assembly is proximate to or in contact with a ground surface. Accordingly, we affirm the Examiner's § 103 rejection of claims 1-6 over Moore.

Rejections (2) and (3): § 103 Rejections over Moore in view of Morse, Jr. and Moore in view of Padilla

STATEMENT OF THE CASE

With regard to each rejection, Appellant argues that there is no motivation for combining the teachings of Morse, Jr. or Padilla with Moore's lighting assembly (App. Br. 4-5). Appellant further argues that Morse, Jr. and Padilla are non-analogous art (App. Br. 4 and 6).

ISSUES

1. Has Appellant shown that the Examiner erred in finding that Morse, Jr. and Padilla are analogous art to the claimed invention? We decide this issue in the negative.
2. Has Appellant shown that the Examiner erred in finding reasons for the combining the teachings Morse, Jr. or Padilla with Moore? We decide this issue in the negative.

PRINCIPLES OF LAW

Motivation may be found in the nature of the problem to be solved, the teachings of the pertinent references or from the ordinary knowledge of those skilled in the art. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

When determining whether a claimed invention would have been obvious over a combination of references, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

FINDINGS OF FACT (FF)

3. Appellant states that the problem the claimed invention is concerned with is “lighted stanchions” (App. Br. 5).

4. The Specification states that the present invention is related generally to protective covers for stanchions (Spec. 1). The Specification further states the invention is directed:
[M]ore particularly to a protective cover with an integrated lighting assembly for the purpose of providing illumination around the stanchion in darkness or other low visibility conditions. (Spec. 1).
5. The Specification states that it is known to customize stanchion covers to display a customer logo or advertisement (Spec. 2). The Specification further states that “[t]he elongated tubular body 22 can be customized to display a message, such as an image or stenciled letters 40” (Spec. 7).
6. Morse, Jr.’s invention is directed to new and useful improvements in stencils for making signs consisting of letters, numerals or both (col. 1, ll. 8-12).
7. Morse, Jr. further discloses that the invention provides a stencil which is “adapted to conform snugly to a curved, or rounded, surface which is to be painted in order to make a neat and legible sign” (col. 1, ll. 27-31).
8. Morse, Jr. discloses that the stencil may be used to form signs on round posts (col. 4, ll. 12-20).
9. Padilla’s invention is a bicycle light device and a new and improved lighting device which provides enhanced durability and visibility (col. 1, ll. 6-10).
10. Padilla discloses that the lighting device uses light emitting diodes (LEDs), which are more durable and provide an

inexpensive and efficient manufacture, in lieu of conventional light bulbs (col. 1, ll. 20-25, col. 4, ll. 31-38).

11. Padilla discloses that the lighting device makes the user more visible at night (col. 1, ll. 6-10).

ANALYSIS

Issue 1: Analogous Art

We begin our analysis by addressing Appellant's analogous art arguments. Appellant too narrowly states that the problem to be solved by the invention is "lighted stanchions." While Appellant discloses providing a light assembly to the stanchion cover to illuminate the stanchion, Appellant further discloses that a stencil may be used to provide markings on the cover presumably to further enhance the visibility of the device as well as improve the aesthetics of the cover. Therefore, we determine that the problem to be solved by Appellant is to enhance the visibility of the stanchion or post as well as improving its aesthetics.

Applying our broader statement of the problem to be solved to the facts of the appeal, Morse, Jr.'s use of a stencil to provide a legible and neat sign on a post would have increased the visibility of a post, as well as enhancing the aesthetics of the post. In other words, Morse Jr.'s invention is directed to the same problem Appellant sought to solve (i.e., enhancing the visibility and aesthetics of a post or stanchion). Accordingly, we find that Morse, Jr.'s invention is directed to the same problem as Appellant's invention and is analogous art.

With regard to Padilla, Appellant's argument focuses solely on the problem to be solved by Padilla as establishing that Padilla is non-analogous

art (App Br. 6). However, Padilla's invention provides a lighting device to increase visibility of an object (i.e., a bicycle). Similarly, Appellant's invention uses a light assembly to increase visibility of a stanchion or post. Accordingly, we find that Padilla's and Appellant's problem to be solved is the same problem.

We also note that Padilla is in the same field of endeavor as Appellant's claimed invention. Specifically, Appellant's claimed invention is directed to a lighting assembly. Similarly, Padilla's device is directed to a lighting assembly. That Appellant intends to use the lighting assembly for a stanchion and Padilla intends to use the lighting assembly for a bicycle, does not change that Padilla and Appellant's invention are directed to lighting assemblies. Appellant does not contest that Padilla is in the same field of endeavor as Appellant's claimed invention (App. Br. 6).

For the above reasons, we find that Morse, Jr. and Padilla are analogous art. We now consider Appellant's motivation arguments.

Issue 2: Motivation

Appellant contends that there is no reason to combine Morse Jr. with Moore because the prior art does not each or suggest the combination (App. Br. 4). However, Appellant fails to appreciate that motivation for a combination of references may be found in the prior art itself, the nature of Appellant's problem to be solved or knowledge of one of ordinary skill in the art. *Rouffet*, 149 F.3d at 1355-56.

The Examiner finds that motivation exists for combining Morse, Jr.'s stencil with Moore's post cover to display messages in a simple manner and with cost savings (Ans. 6). Such a motivation appears to be drawn from the

knowledge of one ordinary skill in the art and nature of the problem to be solved. Specifically, adding a sign to a post increases the aesthetics and visibility of the post such that the nature of the problem to be solved by the Moore and Morse, Jr. would have rendered the combination obvious.

Also, adding signage to a post to increase the visibility and improve aesthetics of the post would have been within the knowledge of one of ordinary skill in the art. Indeed, Appellant admits that addition of stanchion or post covers customized with logos or advertisements is known in the art to increase aesthetics and thus, visibility (Spec. 2).

Accordingly, we determine that Appellant has failed to show error in the Examiner's finding that there is a reason for combining Morse, Jr.'s stenciling to form an image with Moore's post cover.

With regard to Padilla, the Examiner finds that it would have been obvious to modify the tubular cover of the lighted assembly of Moore with the tubular body and LEDs of Padilla's lighting assembly for the "benefits and advantages of high attention value displays, and for traffic safety (Warning) in dark" (Ans. 7). The Examiner further finds that Padilla's LEDs would impart "benefits of high energy efficiency, compactness and long operational life" (Ans. 7). We agree.

Padilla and Moore both use lighting assembly to attract attention of bystanders for safety. Moore uses a strobe light and Padilla uses flashing LEDs. Padilla further teaches that LEDs are durable and provide for efficient and inexpensive manufacture when compared to conventional bulbs. Accordingly, the references provide reasons for modifying Moore's tubular body with a strobe light to use Padilla's LEDs: to provide an attention getting display that is energy efficient and durable.

Appellant contends that there would be no reason for modifying Moore's lighting assembly with Padilla's lighting assembly because Moore's device is intended to be mounted on top of telephone poles such that the desirability of an eye-catching display makes little sense (App. Br. 5). Contrary to Appellant's argument, the Examiner's reason for the modification makes perfect sense. Moore's invention uses a strobe light to attract the attention of aircraft. Accordingly, using Padilla's attention-attracting, energy efficient light assembly in lieu of a strobe light would have been obvious. Such a modification is nothing more than the predictable use of a prior art element (i.e., LEDs) according to its established function (i.e., energy efficient light production). *KSR*, 550 U.S. at 417.

For the above reasons, we determine that Appellant has not shown that the Examiner erred in determining that there are reasons for modifying Moore's light assembly with the teachings of Morse, Jr. or Padilla.

DECISION

We affirm the Examiner's § 103 rejection of claims 1-6 over Moore.

We affirm the Examiner's § 103 rejection of claims 7 and 8 over Moore in view of Morse, Jr.

We affirm the Examiner's § 103 rejection of claims 9-11 over Moore in view of Padilla.

The Examiner's decision is affirmed.

Appeal 2008-5559
Application 09/829,033

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v)(2008).

ORDER
AFFIRMED

cam

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APPENDIX C
RELATED PROCEEDINGS

None.